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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,872	02/28/2002	Thomas A. Zdeblick	4002-2954/PC393.06	1196

7590

06/21/2004

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EXAMINER
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BARRETT, THOMAS C

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 06/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/085,872

Applicant(s)

ZDEBLICK ET AL.

Examiner

Thomas C. Barrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 52-77 is/are pending in the application.
- 4a) Of the above claim(s) 55-57, 60 and 61 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 52, 53, 65-73, 76 and 77 is/are allowed.
- 6) ☒ Claim(s) 54 and 58 is/are rejected.
- 7) ☒ Claim(s) 59, 62-64, 74 and 75 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3-22-04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments with respect to claims 52-54, 58-59, and 62-71 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pisharodi (5,123,926) in view of Beyar et al. (6,127,597). Pisharodi discloses a method of inserting an artificial disc implant comprising upper and lower shells with a compressible spacer in between, the implant rigidly engaging the vertebral endplates, the method comprising reducing the height (Fig. 4), implanting the device, and expanding the device (Fig. 2), however Pisharodi fails to disclose the method comprising inserting the implant through a sleeve. Beyar et al. teaches a method of percutaneous intervertebral surgery (col. 4, line 14- col. 5, line 38), circumventing the need for exposing the vertebra with subsequent invasive surgery. It would have been obvious to one of ordinary skill in the art to combine the teaching of a method of percutaneous intervertebral surgery, as taught by Beyar et al., to a method of inserting an artificial disc implant as per Pisharodi, in order to circumvent the need for

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exposing the vertebra with subsequent invasive surgery.

Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pisharodi (5,123,926) in view of Beyar et al. (6,127,597), and in further view of Houfburg et al. (6,171,339 B1). Pisharodi discloses a method of inserting an artificial disc implant however Pisharodi fails to disclose the preparing the implant location through a double-barreled sleeve. Houfburg et al. teaches a method for inserting an implant into the anterior of a disc space (col. 7, line 12- col. 8, line 25) comprising: preparing the implant location (col. 8, lines 18-20) through a double-barreled sleeve (12), which facilitates the ease and accuracy of placement of multiple spinal implants (col. 4, lines 13-15). It would have been obvious to one of ordinary skill in the art to combine the teaching of preparing a disc implant location through a double barreled sleeve, as taught by Houfburg et al., to a method for inserting an implant as per Pisharodi, in order to facilitate the ease and accuracy of placement of multiple spinal implants.

***Allowable Subject Matter***

Claims 52-53, 65-73, and 76-77 are allowable over the prior art of record.

Claims 59, 62-64, and 74-75 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas C. Barrett whose telephone number is (703) 308-8295. The examiner can normally be reached Tuesday-Friday between 9:00 A.M. and 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703) 308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications.

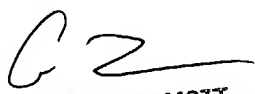
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas Barrett



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